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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,760	01/22/2001	Jeffrey Jacobson	21300.105006	1263
20786	7590	09/28/2005	EXAMINER	
KING & SPALDING LLP			GARG, YOGESH C	
191 PEACHTREE STREET, N.E.			ART UNIT	
45TH FLOOR			PAPER NUMBER	
ATLANTA, GA 30303-1763			3625	

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,760

Applicant(s)

JACOBSON ET AL.

Examiner

Yogesh C. Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 1-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/22/03 &amp; 6/6/05</u> | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. Applicant's amendment received on 3/29/2004 is acknowledged and entered. All the earlier filed claims 1-10 are amended and have also added new claims 11-20. Currently claims 1-20 are pending for examination.

### *Response to Arguments /Election/Restrictions*

2.1. Applicant's arguments, see Remarks pages 9-18 filed on 3/29/2004, with respect to claims 1-20 have been considered but are moot in view of the applicant's shift to claiming another invention after an election is once made and action given on the elected subject matter.

Newly submitted and extensively amended claims 1-10 and new claims 10-20 which are dependencies of the currently amended claims 1 and 6 filed on 3/29/2004 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Newly submitted and extensively amended claims 1-5, 9 and the new claims 11-20 recite a new limitation, that is ***each of client computers is operated by a call center agent to provide telephone call support for a real estate.....*** (see independent claim 1, claims 9 and 11 which are dependencies of claim 6, and Remarks, pages 9-12, confirm claiming a new invention comprising call centers for providing telephone support for real estate transactions) has a different utility than the earlier

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claimed inventions. The applicant has already elected an invention, that is originally filed claims 1-10 on 1/22/2001, directed to a system and method for aggregating real estate information which did not recite or need a utility for telephone call-center agents for providing support for real estate transactions.

Similarly, newly submitted and extensively amended claims 6-8 and 10 recite a new limitation that is, ***providing at the server platform a real estate processing tool operative to receive financial information for a real estate transaction, generate derived financial information in response to processing said financial information in response to .....and transmit the derived financial information to the computer via the distributed computing environment*** (see claim 6 and Remarks, pages 14-15) have a different utility than the earlier claimed inventions. The applicant has already elected an invention, that is originally filed claims 1-10 on 1/22/2001, directed to a system and method for aggregating real estate information which did not recite an utility or need for ***providing at the server platform a real estate processing tool operative to receive financial information for a real estate transaction, generate derived financial information in response to processing said financial information in response to .....and transmit the derived financial information to the computer via the distributed computing environment*** (see claim 6 and Remarks, pages 14-15).

Therefore the newly submitted amended claims 1-10 and new claims 11-20 are distinct and divergent from the earlier claimed inventions and would require a new, divergent and different search. Such change in the inventions amount to a " Shift

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claiming another invention after an election is once made and action given on the elected subject matter and are therefore subject to "Election by Original Presentation". as analyzed above.

Kindly refer to the following MPEP excerpts for guidelines:

**819 Office Generally Does Not Permit Shift:**

The general policy of the Office is not to permit the applicant to shift to claiming another invention after an election is once made and action given on the elected subject matter. Note that the applicant cannot, as a matter of right, file a request for continued examination (RCE) to obtain continued examination on the basis of claims that are independent and distinct from the claims previously claimed and examined (i.e., applicant cannot switch inventions by way of an RCE as a matter of right). When claims are presented which the examiner holds are drawn to an invention other than the one elected, he or she should treat the claims as outlined in **MPEP § 821.03**.

Where the inventions are distinct and of such a nature that the Office compels restriction, an election is not waived even though the examiner gives action upon the patentability of the claims to the nonelected invention. *Ex parte Loewenbach*, 1904 C.D. 170, 110 O.G. 857 (Comm'r Pat. 1904) and *In re Waugh*, 135 F.2d 627, 57 USPQ 371 (CCPA 1943).

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**821.03 Claims for Different Invention Added After an Office Action - 800 Restriction in Applications Filed Under 35 U.S.C. 111; Double Patenting**

**821.03 Claims for Different Invention Added After an Office Action**

Claims added by amendment following action by the examiner, **MPEP § 818.01, § 818.02(a)**, to an invention other than previously claimed, should be treated as indicated by **37 CFR 1.145**.

**37 CFR 1.145 Subsequent presentation of claims for different invention.**

If, after an office action on an application, the applicant presents claims directed to an invention distinct from and independent of the invention previously claimed, the applicant will be required to restrict the claims to the invention previously claimed if the amendment is entered, subject to reconsideration and review as provided in **§§ 1.143 and 1.144**

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The action should include form paragraph 8.04.

**¶ 8.04 Election by Original Presentation.....**

.....  
An amendment canceling all claims drawn to the elected invention and presenting only claims drawn to the nonelected invention should not be entered. Such an amendment is nonresponsive. Applicant should be notified by using form paragraph 8.26.

3. Therefore, newly submitted and extensively amended claims 1-10 and new claims 11-20 are directed to an invention that is independent or distinct from the invention originally claimed for the reasons given above.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 1-20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. The amendment filed on 3/29/2004 presenting only claims drawn to a non-elected invention is **non-responsive** (MPEP § 821.03). The currently amended claims 1-10 and newly added claims 11-20 are not readable on the elected invention because they are subject to "Election by Original Presentation", as analyzed above.

5. Since the above-mentioned amendment appears to be a *bona fide* attempt to reply, applicant is given a TIME PERIOD of ONE (1) MONTH or THIRTY (30) DAYS, whichever is longer, from the mailing date of this notice within which to supply the

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omission or correction in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD UNDER 37 CFR 1.136(a) ARE AVAILABLE.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C. Garg whose telephone number is 571-272-6756. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 571-272-7159. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yogesh C Garg  
Primary Examiner  
Art Unit 3625

YCG  
September 26, 2005